

**REMARKS**

Favorable reconsideration is respectfully requested in view of the foregoing amendments and the following remarks.

**I. Examiner Interview, Claim Status, and Amendments**

Applicants thank Examiner Rahmani for her time and consideration of the present application during the telephone interview with the undersigned on June 10, 2009.

Claims 1-7, 9-12, and 14-20 are pending in this application. Claims 1-3, 11-12, and 14-17 have been finally rejected. Claims 4-7, 9, 10, 19, and 20 are objected to but indicated as allowable if rewritten in independent form including all the limitations of the base claims and any intervening claims. Claim 18 is indicated as allowed. See item 5 on page 1 and item 7 on page 4 of the Office Action. Applicants appreciate the Examiner's indication of allowable subject matter.

Claims 1, 3, 10, 11, 14, 16, and 18 have been amended by way of the present amendment. As discussed in the interview, the amendments are believed to be non-substantive and are being made to address the formal matters raised in the Office Action. For instance, the amendments clarify the nature of the invention and correct punctuation and grammar. Support for the revisions can be found throughout the general

disclosure and the claims as filed. No new matter has been added.

As discussed in the interview, it is believed that the amendments must be entered and considered after final rejection, because the subject matter of the amended claims was fully considered in the current Office Action.

For instance, Applicants have revised claims 1 and 11 to replace the language "with the proviso that when  $R^1$  and  $R^2$  are both  $-CH_2-OR^5$  then  $R^5$  is not H" with "with the proviso that when  $R^1$  and  $R^2$  are both  $-CH_2-OR^5$  then both  $R^5$  are not H" to clarify the language and use correct grammar. The preamble of claim 1 is also revised to properly recite a method of treating in the manner suggested by the Examiner in item 4 on page 2 of the Office Action. These are non-substantive revisions and should not raise any new issues.

Also, claim 3 is revised to addresses the formal matters raised in the Office Action. Support can be found in the disclosure, at page 5, line 21 to page 6, line 7, and the bottom of page 6. The amendment should not raise any new issues, because the amendment does not change the scope of protection and it simply clarifies the claim language.

Lastly, other minor editorial revisions have been made to claims 1, 3, 10, 11, 14, 16, and 18 to use correct grammar and punctuation.

Thus, there is nothing that would require further consideration and/or search, and hence no ground for refusing to enter this amendment. Applicants respectfully request entry and consideration of the present amendment.

Claims 1-7, 9-12, and 14-20 will remain pending upon entry of this amendment, and these claims define patentable subject matter warranting their allowance for the reasons discussed herein.

In the event that the Examiner believes that further changes are needed to allow the claims, then please contact the undersigned attorney as Applicants would be willing to discuss proposals to obtain the allowable subject matter.

## II. Enablement Rejection Under 35 USC §112

The Examiner maintained the enablement rejection of claims 1-2, 11-12 and 14-17 under 35 USC §112, first paragraph, for the reasons in item 4 on page 2 of the Office Action. Specifically, the Examiner indicated that the Rule 132 Declaration by Dr. Mohell (submitted December 23, 2008 in response to the enablement rejection in the Office Action of June 23, 2008) is acceptable but the claim language needs to be changed to "a method of treating a disorder by using a compound of formula (I)".

In reply, Applicants have amended the claims in the manner suggested in the Office Action. However, it should be

noted that only independent claim 1 needs to be amended in this manner, because the remaining independent claims, i.e., claims 11 and 16, already contain the "method of treating a disorder" language suggested by the Examiner. Accordingly, Applicants have amended only claim 1 in the manner suggested in the Office Action. It is believed that this amendment overcomes the sole remaining enablement rejection. Withdrawal of the rejection is therefore requested.

In the interview, the Examiner asked whether further claim amendments are needed to specify treatment of a specific cancer. Applicants disagree. As discussed in the interview, the specification fully enables the claimed methods for the reasons set forth in the traversal on pages 19-20 of the response filed December 23, 2008. Applicants again note that the current enablement rejection mentions nothing with respect to limiting the claims to specify a specific cancer. Also, as previously discussed, the Examiner has already acknowledged that the Rule 132 Declaration, in combination with the present amendment, is acceptable to overcome the enablement rejection. Thus, it is believed that no further changes are needed, as the present amendment fully addresses and overcomes the rejection of record.

If the Office now intends to require further amendments (which Applicants do not believe are warranted), it is respectfully submitted that such a requirement would

constitute a new ground of rejection requiring a new and non-final Office Action.

**III. Written Description Rejection - 35 USC §112**

Claim 3 was rejected under 35 USC §112, first paragraph, as failing to comply with the written description requirement for the reasons in item 5 on page 2-3 of the Office Action. The Examiner contends that the recitation "R<sup>3</sup> is =O, provided that at least one of R<sup>1</sup> and R<sup>2</sup> is selected from -CH<sub>2</sub>-O-CO-R<sup>5</sup>, -CH<sub>2</sub>-O-CO-NR<sup>4</sup>R<sup>5</sup> and -CH<sub>2</sub>-O-CO-OR<sup>5</sup>" constitutes new matter. The basis for the rejection, as best understood by Applicants, is that the description of R<sup>1</sup> and R<sup>2</sup> in the specification is directed to a very large group of compounds, and not just the three items recited in the claim. Applicants disagree and traverse the rejection.

As noted in the interview, it is well established in US law that a description of a list of compounds in a patent specification provides written description support for claims directed to species of individual compounds from those recited in the specification. Such practice is long and well established in the chemical arts where, for instance, a patent specification may recite a list of compounds (perhaps in a Markusk listing), which properly supports claims to certain species of compounds from those recited in the disclosed list.

This is the situation in the instant application. Support for the objected language can be found either explicitly or implicitly throughout the disclosure. See for instance, the description at lines 24-26 on page 5 of the application, which describes in relation to the compound of formula (I) that: " $R^1$  and  $R^2$  are the same or different and are selected from H,  $-CH_2-O-CO-R^5$ ,  $-CH_2-O-CO-NR^4R^5$  and  $-CH_2-O-CO-OR^5$ ". Such language can also be found in original claim 3. See also the disclosure at page 5, line 21 to page 6, line 7. It is believed that this disclosure provides written support for the "at least one of  $R^1$  and  $R^2$  is selected from  $-CH_2-O-CO-R^5$ ,  $-CH_2-O-CO-NR^4R^5$  and  $-CH_2-O-CO-OR^5$ " language of claim 3, as all compounds are clearly recited in the disclosure.

Nonetheless, as discussed in the interview and for the sole purpose of expediting prosecution and not to acquiesce to the rejection, Applicants have amended claim 3 to remove the objected language and further revise the claim to recite "with the proviso that  $R^1$  and  $R^2$  are not both selected from H and  $-CH_2OH$ " to clarify the nature of the invention in a manner believed to be supported in the specification. In the interview, the Examiner questioned the use of negative limitations in the claims. Applicants noted that US patent law permits Applicants to include a negative limitation or an exclusionary proviso in claim so long as it has basis in the original disclosure. See MPEP §2173, which states:

"Any negative limitation or exclusionary proviso must have basis in the original disclosure. If alternative elements are positively recited in the specification, they may be explicitly excluded in the claims. See *In re Johnson*, 558 F.2d 1008, 1019, 194 USPQ 187, 196 (CCPA 1977) ("[the] specification, having described the whole, necessarily described the part remaining."). See also *Ex parte Grasselli*, 231 USPQ 393 (Bd. App. 1983), *aff'd mem.*, 738 F.2d 453 (Fed. Cir. 1984)."

In this regard, support for amended claim 3 is believed to be found in the disclosure, for example, at page 5, line 21 to page 6, line 7, and the bottom of page 6.

For these reasons, it is believed that the amendment renders the rejection moot. Therefore, withdrawal of the rejection is requested.

#### IV. Claim Objection

Claims 4-7, 9-10, 19 and 20 stand objected to as being dependent upon a rejected base claim 3, but would be allowable if rewritten in independent form including all of the limitations of the base claims and any intervening claims. See item 6 on page 3 of the Office Action. Applicants again thank the Examiner for noting the allowable subject matter.

The present amendment obviates the objection by amending the claims in a manner believed to overcome the remaining rejections. Therefore, withdrawal of the objection is requested.

V. Conclusion

Having addressed all the outstanding issues, the amendment is believed to be fully responsive to the Office Action.

It is respectfully submitted that the claims are in condition for allowance and favorable action thereon is requested.

In the event that the Examiner believes that further changes are needed to allow the claims, then please contact the undersigned attorney as Applicants would be willing to discuss proposals to obtain the noted allowable subject matter.

Respectfully submitted,

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